

REMARKS

Claims 24-29 are pending in this application. By this Amendment, claim 24 is amended to correct an informality. No new matter is added. Claims 18-23 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed below; (b) do not raise any new issue requiring further search and/or consideration as the amendments cancel claims and correct an informality; (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

The Office Action, in paragraph 4, objects to claim 24 for an informality. Claim 24 is amended to obviate the objection. Withdrawal of the objection to claim 24 is respectfully requested.

The Office Action, in paragraph 7, rejects claims 18-29 under 35 U.S.C. §103(a) as allegedly being unpatentable over JP-A-2003-112532 (hereinafter "JP '532") in view of U.S. Patent Application Publication No. 2001/0026430 A1 to Onizuka et al. (hereinafter "Onizuka"). The rejection as to claims 18-23 is rendered moot by the cancellation of those claims. The rejection is respectfully traversed with regard to claims 24-29.

Claim 24 recites, among other features, the case incorporating the on-vehicle circuit unit and other circuit components while exposing the outer surface of the heat radiating member to an outside of the case, and the case has a mounting portion which is fixed to the

engine room to make the outer surface of the heat radiating member face an inner surface of the engine room with a clearance between the heat radiating member and the inner surface of the engine room. This configuration promotes heat radiation from the heat radiating member on the on-vehicle circuit unit while incorporating and protecting the unit together with other circuit components within the case. The combination of JP '532 and Onizuka would not have rendered obvious at least this combination of features.

JP '532 discloses an ECU case. The case 8, however, of JP '532 does not incorporate an on-vehicle circuit unit having both a circuit board and a heat radiating member with an inner surface to which the circuit board is fixed and an outer surface functioning as a heat radiating surface so as to expose the radiating member of the circuit unit. Case 8 in JP '532 incorporates a circuit board, but the circuit board has no heat radiating member. Therefore, the case 8 of JP '532 cannot be considered to correspond to the combination of all of the features positively recited in the pending claims. The Office Action concedes that JP '532 "does not disclose that the case is other than the heat radiating member." Rather, the Office Action relies on Onizuka in its teachings of a power distributor for a vehicle and production thereof, which is of course necessarily different from an automatic transmission having an electronic control device, as described in JP '532, as allegedly making up for the shortfall in the application of JP '532 to the subject matter of the pending claims. The conclusion of the Office Action in this regard fails for at least the following reasons.

As indicated above, Onizuka teaches a power distributor for a vehicle. Applicants understand Onizuka to disclose only an on-vehicle circuit as recited in the pending claims, and to fail to disclose the other circuit components recited in the pending claims. Further, Onizuka does not describe mounting the disclosed device on a wall of an engine room. For at least these reasons, Onizuka cannot be relied upon to disclose incorporation of the on-vehicle circuit unit and the other circuit components in a common case, as is required by the claims,

or to disclose a mounting portion of the case to be fixed to the engine room so as to make the outer surface of the heat radiating member face of the on-vehicle circuit unit, as is also required by the claims. For at least these reasons, any permissible combination of JP '532 with Onizuka, which Applicants do not concede are combinable for at least the reasons set forth below, would not have rendered obvious the combination of all of the features positively recited in independent claim 24, and therefore also in the claims depending therefrom.

Further, the conclusory statement that it would have been obvious "to modify the apparatus of [JP '532] by adding that the case is other than the heat radiating member as taught by Onizuka in order to make it easier to manufacture and assemble the different components" fails factually necessarily based at least on the fact that there is no evidence to support this conclusion presented in the record. As indicated briefly above JP '532 discloses an automatic transmission having an electronic control unit (ECU) integrally mounted thereon. Simply because the references deal with widely disparate on-vehicle components, does not make it as simple a matter as the Office Action suggests to combine these references in the manner suggested. JP '532 and Onizuka are completely different devices directed at completely different vehicular components and are designed to achieve different objectives. In considering the references as a whole, as the Office Action must, it is clear that the that the references are not combinable in the manner suggested by the Office Action. Further, the alleged rationale for making the combination is not based, as indicated above, on any evidence of record. There is nothing in either of the references, nor has any other evidence been presented to suggest that one of ordinary skill in the art would have reasonably attempted to make the asserted combination for any reason. It is improper for the Office Action to simply decide that some ease of construction regarding some consolidated box based on differing components from these references may have been easier to construct than

the devices disclosed individually in either of the references. To assert otherwise, only posits an unreasonable obviousness position based on the clear teachings of the reference.

Additionally, the above conclusory statement fails legally because it does not present proper evidence by which to prove that there is any reasonable predictability to making the asserted combination for any reason with any reasonable expectation of success that would have been recognized by one of skill in the art in considering the problem addressed by the subject matter of the pending claims. The Federal Circuit has consistently reaffirmed its prior holdings, and the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) confirmed, that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (quoting *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002), and *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)). This standard is not met here as the articulated reasoning is unreasonable and cannot, therefore, be based on any rational underpinning.

The Supreme Court, in *KSR*, warned against just the type of analysis that is undertaken by this Office Action. The *KSR* Court opined "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known" (citation omitted).

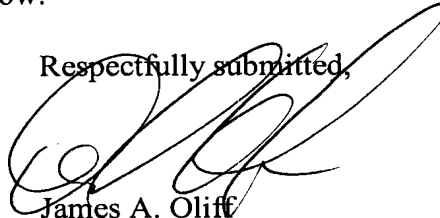
The Office Action fails to provide any reasonable basis for the bare assertion regarding combining the references in the manner suggested.

For at least the foregoing reasons, claim 24, and claims 25-29 depending therefrom, are patentable over the currently-applied references.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 24-29 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:DAT/cfr

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